

Patent  
Attorney Docket: 612,404-387  
(Former L&L Ref: 267/242)

REMARKS

Applicant thanks the Examiner for taking the time on March 11, 2003, to discuss the office action, mailed on November 22, 2002. Applicants have amended claims 1, 4, 12-13, and 16. Support for these amendments can be found in the specification at, e.g., FIGS. 1-2 and accompanying text, page 34, lines 7-12, and page 35, line 10 – page 36, line 2, and page 21, line 32 – page 22, line 9;

35 U.S.C. §112, second paragraph

Claims 16-24 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. In particular, the examiner objects to the last phrase of claim 16 reading “elongating the target polynucleotide under conditions that the target polynucleotide sequence is amplifiable.” Applicant has amended the last phrase of claim 16 to read “elongating the target polynucleotide sequence by adding the nucleotide triphosphates.” Therefore, applicant respectfully requests withdrawal of the rejection and reconsideration of the claims as amended.

Priority

The examiner has rejected the applicant's claim of priority to U.S. Application 08/250,951, filed May 27, 1994, now U.S. Patent No. 5,532,129, with respect to claims 4, 12, and 13. Applicants have amended claims 4, 12, and 13.

Patent  
Attorney Docket: 612,404-387  
(Former L&L Ref: 267/242)

35 U.S.C. § 103(a)

Claims 4, 12, and 13 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heller (U.S. Patent No. 5,849,489) in view of Kidwell et al. (U.S. Patent No. 5,332,659). In light of the above statements regarding the correct claim of priority, this rejection becomes moot since this application claims priority to U.S. Application Serial No. 08/250,951, now U.S. Patent No. 5,532,129, which is the parent application of U.S. Patent No. 5,849,489.

Claims 1-3, 5-7, 10, 11, 14, 16-19, 22 and 23 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Cardullo et al. (Proc. Natl. Acad. Sci. (1988) 85: 8790-8794) in view of Morrison et al. (Anal. Biochem. (1989) 183: 231-244). The combination of prior art, however, does not disclose or teach all of the limitations of the pending claims as currently amended. Claims 1 and 16 have been amended to specify that the “donor chromophore and acceptor chromophore are in an energy transfer relationship that substantially eliminates quenching.” The Morrison reference discusses the problem of quenching with respect to the Cardullo reference. (P. 242, Col. 1). Because the claims are limited to establishing a relationship between acceptor and donor chromophores that substantially eliminates quenching, these references teach away from the invention described in the claims as amended.

Claims 8, 9, 20, and 21 were also rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Cardullo et al. (Proc. Natl. Acad. Sci. (1988) 85: 8790-8794) in view of Morrison et al. (Anal. Biochem. (1989) 183: 231-244) as applied to claims 1-3, 5-7, 14, and 16-19, and further in view of Matthews et al. (Anal. Biochem. (1988) 169: 1-25). Specifically, the examiner alleges that Matthews et al. teaches solid support immobilization strategies.

Patent  
Attorney Docket: 612,404-387  
(Former L&L Ref: 267/242)

Claims 15 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cardullo et al. (Proc. Natl. Acad. Sci. (1988) 85: 8790-8794) in view of Morrison et al. (Anal. Biochem. (1989) 183: 231-244) as applied to claims 1-3, 5-7, 14, and 16-19, and further in view of Gelfand (U.S. Patent No. 5,322,770). Specifically, the examiner alleges that Gelfand teaches RT-PCR methods to amplify mRNA.

Similar to the arguments made above, these combinations of prior art references, however, do not disclose or teach all of the limitations of the pending claims as currently amended. Applicant respectfully requests withdrawal of the rejections and reconsideration of the claims as amended.

Patent  
Attorney Docket: 612,404-387  
(Former L&L Ref: 267/242)

CONCLUSION

With these amendments and comments, applicant believes that the pending claims are now in condition for allowance. Prompt and favorable action on the merits of the claims is earnestly solicited. The Commissioner is hereby authorized to charge Deposit Account 50-0639 for the \$205 two-month extension fee and any additional fees that may be required.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: April 22, 2003

By: John Kappos  
John Kappos  
Reg. No. 37,861  
Attorneys for Applicant

JCK/DKW/cp



34263

PATENT TRADEMARK OFFICE

O'Melveny & Myers LLP  
114 Pacifica, Suite 100  
Irvine, CA 92618-3315  
(949) 737-2900